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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/849,966	05/04/2001	Hiroyuki Hyodo	2803-65479	9327

7590

12/11/2002

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EXAMINER

RESAN, STEVAN A

ART UNIT

PAPER NUMBER

1773

7

DATE MAILED: 12/11/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

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**Office Action Summary**

Application No.

09/849,966

Applicant(s)

HYODO ET AL.

Examiner

Stevan A. Resan

Art Unit

1773

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04 November 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 14-17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 and 18-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☒ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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1. Applicant's election with traverse of Group I claims 1-13 and 18-20 in Paper No. 6 is acknowledged. The traversal is on the ground(s) that the examiner has not shown that Group I and Group II inventions are distinct as claimed since both Group I and Group II recite the use of the Filtered Cathodic Arc Process and that no serious burden has been shown. This is not found persuasive because the article claims are distinct from the process claims since process limitations carry no weight in article claims unless it can be shown that they produce a patentably distinct product. A "serious burden" is shown when different classifications of the inventions have been shown.

The requirement is still deemed proper and is therefore made FINAL. However, if article claims are found allowable, process claims may be rejoined, upon request, by placing all of the claim limitations of the allowable article claim into the process claims as per *In re Ochai et al.*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-6 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Veerasamy US 6,303,225.

4. Claims 1-2, 5-9, 12, 13, 18 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Veerasamy 5,858,477.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 3, 4, 10, 11, 19, 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Veerasamy et al US 5,858,477 as applied to claims 1, 8, 18 above, and further in view of Veerasamy 6,303,225 and Takahashi et al JP-10-143836.

Veerasamy '477 discloses the invention as claimed in claims 1, 8, 18. (Process limitations carry no weight in article claims unless they can be shown to produce a patentably distinct article.) Veerasamy et al '477 do not disclose a layer having a nitrogen distribution as in claims 3, 4, 10, 11, 19, 20, however Veerasamy '225 clearly provides the teaching ( See Fig 2, Col 7 lines 9-49). Therefore it would have been obvious to one of ordinary skill in the art to provide a structure as in Fig. 2 in order to provide more polar groups at the surface which would strongly adhere to an overcoated lubricant to improve durability as taught by Takahashi et al (see [0008] ).

Note that the present specification page 3 lines 6-13 is incorrect with respect to the teachings of Takahashi.

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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Tani et al is cited for teaching that high energy surfaces have low water contact angles and adhere better to overcoated lubricant films having polar groups.

Ono et al is cited for teaching a magnetic disk having a carbon layer in the CSS zone with a 15 to <19 Gpa hardness and a carbon layer in the data zone having a hardness > or = to 19 Gpa.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stevan A. Resan whose telephone number is (703) 308-4287. The examiner can normally be reached on Tues-Fri from 7:30AM to 6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Thibodeau, can be reached on (703) \*308-2367. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-7718.

  
STEVAN A. RESAN  
PRIMARY EXAMINER